

UNITED STATES PATENT AND TRADEMARK OFFICE **MAY 12 2000**
BEFORE THE DIRECTOR
OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

Decision on
Petition for Regrade
Under 37 C.F.R. § 10.7(c)

(petitioner) petitions for regrading his answers to questions 3, 7, 11, 19, 29 and 34 of the afternoon session of the Registration Examination held on November 3, 1999. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in the Registration Examination. Petitioner scored 65. On February 23, 2000, petitioner requested regrading, arguing that the model answers were incorrect.

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the examination. The directions state: “No points will be awarded for incorrect

answers or unanswered questions.” The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is “All of the above,” the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms “USPTO,” “PTO,” or “Office” are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers.

All of petitioner’s arguments have been considered. Each question in the examination is worth one point.

Petitioner has been awarded three points for afternoon questions 11, 19 and 29.

Accordingly, petitioner has been granted an additional three points on the examination, resulting in a regraded score of 68. However, no credit has been awarded for questions 3, 7, and 34 of the afternoon session.

Afternoon question 3 reads as follows:

3. Smith received a second Office action in his pending application finally rejecting pending claims 1-20 on prior art grounds. Claims 1 and 11 are presented in independent form, claims 2-10 depend from claim 1, and claims 12-20 depend from claim 11. To continue prosecution, Smith submitted an Amendment After Final Rejection narrowing the scope of independent claims 1 and 11. Smith believed the Amendment placed the application in condition for allowance and, accordingly, requested entry of the Amendment and allowance of the application. However, the Examiner denied entry on the ground that the Amendment presented new issues requiring further consideration or search. Rather than appeal the rejection, Smith filed a request for a Continuing Prosecution Application (CPA), and asked that the Amendment After Final be entered as a Preliminary Amendment. The Examiner issued a first Office action in the CPA allowing claims 1-10 and finally rejecting claims 11-20 on substantially the same grounds that these claims had been rejected in the parent application. Which of the following statements regarding the first Office action in the CPA is correct?

- (A) The Examiner cannot properly allow claims 1-10 because a determination was made in the parent application that the Amendment After Final Rejection presented new issues requiring further consideration or search.
- (B) The Examiner is precluded from rejecting claims 11-20 on substantially the same grounds that these claims had been rejected in the parent application because a determination was made in the parent case that the Amendment After Final Rejection presented new issues requiring further consideration or search.
- (C) The Amendment After Final Rejection cannot be entered as a Preliminary Amendment in the CPA application.
- (D) The finality of the rejection of claims 11-20 is improper.
- (E) (B) and (D).

Choice (D) is the most correct answer because since the Amendment After Final Rejection was denied entry, a first Action final rejection in the CPA is improper. MPEP § 706.07(b). (A) is incorrect because it is based on the false premise that a determination had been made that the revisions did not put Claim 1 in condition for allowance. In any event, the Examiner would be free to reconsider such a determination even if it had been made. (B) is incorrect because the Examiner could well determine, after further consideration, that the revisions do not overcome the rejection of claims 11-20 made in the parent application. The Examiner is not precluded from making such a determination or from rejecting the claims on

substantially the same grounds as in the parent application. (C) is incorrect because the applicant may request that the amendment after final be entered in the CPA before issuance of an Office action. See MPEP § 714, 714.09. (E) is incorrect because (B) is incorrect.

Petitioner contends that choice (E) is the most appropriate choice because both (B) and (D) are true. Petitioner argues that (B) is true because Examiner is precluded from making a first action final rejection.

Petitioner's arguments are not persuasive. Choice (E) is not the correct answer because (B) is not correct. Petitioner argues that answer (B) is essentially the same as answer (D), i.e. that both answers say the Examiner cannot make the action final. Answer (B) says nothing about and is silent respecting the issue of whether the action may be made final, and instead addresses whether the claims in the CPA may be rejected on substantially the same grounds as used previously. There is no question of propriety of the finality of the action in answer (B). Thus, (B) is not substantially the same as (D) and choice (E) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 7 reads as follows:

7. You were drafting a patent application claiming a widget invented by your client Able. While drafting the application, you looked through a recent Official Gazette and noticed a patent, No. 888,888,888, directed to a widget that appears to be the same as the widget you are claiming. You obtained a copy of the patent and discovered that the patent was granted on May 4, 1999, to your client's strongest competitor, QED Incorporated. Claim 5 in the QED patent is the same widget Able invented. Claim 6 in the QED patent is an improvement to Able's widget. The QED patent was granted on a patent application filed on December 22, 1997. You have evidence that Able invented his widget before December 22, 1997. You copied, as claim 9 in Able's application, QED claim 5. Today, November 3, 1999, you are about to file, in the PTO, Able's nonprovisional patent application containing claim 9, and an information disclosure statement (IDS) listing several patents, including the QED patent, and publications. Which of

the following would be the most proper course of action to take to comply with your duties to your client and the PTO?

- (A) In the IDS, state and explain why the identified patents may be relevant, and state that the burden has shifted to the examiner to find and disclose other pertinent or relevant prior art.
- (B) Identify the QED patent in bold in the list in the IDS, and include the following explanation about the QED patent: "QED discloses a relevant type of widget."
- (C) In the IDS, state, "The QED patent discloses a relevant type of widget," and provide a copy of the patent.
- (D) In the IDS, state, "Claim 9 in this application has been copied from claim 5 in the QED patent," and provide a copy of the patent.
- (E) In the IDS, state, "Claim 9 in this application has been copied from a claim in a QED patent," and argue that "Claim 6 in the QED patent is an obvious improvement to the instant invention," and provide a copy of a QED patent.

Choice (D) is the most correct answer because of the requirements of 37 CFR §§ 1.97; 1.98; 1.607(c); and 10.23(c)(7). (A), (B) and (C) are not correct because they do not identify the number of the patent claim that has been copied. (E) is not the most proper course of action to take. The IDS does not identify the QED patent from which the claim was copied. Arguing that Claim 6 of the QED patent is an obvious improvement to the instant invention would not be considered relevant. 37 CFR § 1.98(a)(3).

Petitioner contends that choice (C) is correct because choice (C) implies that the specific interfering claim is presented in the application whereas choice (D) specifies that the interfering claim is presented in the IDS. Petitioner relies on 37 CFR § 1.604(a)(1) to show that the interfering claim must be shown in the application.

Petitioner's arguments are not persuasive. Choice (C) is not the correct answer because it directly violates 37 CFR § 10.23(c)(7) "Conduct which constitutes a violation of paragraphs (a) and (b) of this section includes, but is not limited to: ...Knowingly withholding from the Office information identifying a patent or patent application of another from which one or more claims

have been copied. See § § 1.604(b) and 1.607(c) of this subchapter.” Choice (C) does not indicate that the interfering claim is disclosed anywhere, petitioner may not assume that the explicit omission in (C) is necessarily implicitly covered by conduct required by the rules and regulations. Further, petitioner’s reliance on the requirement in 37 CFR § 1.604(a)(1) to show the interfering claim in the application is improper because the application referred to in 37 CFR § 1.604 (a)(1) is the application of the interfering party, not the application of the party provoking the interference.

“§ 1.604 Request for interference between applications by an applicant.

(a) An applicant may seek to have an interference declared with an **application of another** by,

(1) Suggesting a proposed count and presenting at least one claim corresponding to the proposed count or identifying at least one claim **in its application** that corresponds to the proposed count,” (Emphasis added.)

Further, 37 CFR § 1.604 does not apply to the problem because the interference is sought with a patent, which is governed by 37 CFR § 1.607, as contrasted with another application, which is governed by 37 CFR § 1.604. Therefore the rules do not imply that the applicant has indicated the interfering claim in his application. Thus, failing to disclose which claim is interfering is inappropriate for the situation presented in the question and choice (C) is incorrect. Choice (D) does not present conduct proscribed by 37 CFR § 10.23(c)(7). No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 34 reads as follows:

34. Your client, Vada, disclosed the following information to you. While vacationing on a desert island, she discovered a salt lake where the water was a solution saturated with NaCl. Vada experimented with the solution and determined that it could be used to cure skin rashes if applied directly to the skin. By further experimentation, Vada determined that the best results could be obtained if the solution were first heated to an ideal temperature (T_i) equal to skin temperature (T_s) plus the square of the difference between room temperature (T_r) and skin temperature (T_s). Vada documented her findings in the form of the following equation: $T_i = T_s + (T_r - T_s)^2$. Vada further experimented and found that she could obtain the exact same solution that she discovered while vacationing, by mixing NaCl with water followed by heating the mixture to 212°F and cooling it to 80°F. You draft a patent application with a specification including all the information disclosed to you by Vada. Which, if any, of the following claims, included in the application, would provide the proper basis for a rejection pursuant to 35 U.S.C. § 101?

- (A) A composition comprising: water saturated with NaCl.
- (B) A composition for restoring youth.
- (C) A composition and method for treating skin rashes, comprising: a solution of water saturated with NaCl; heating said solution to a temperature defined by skin temperature plus the square of the difference between room temperature and skin temperature; and applying said solution to skin rashes.
- (D) An expression comprising: $T_i = T_s + (T_r - T_s)^2$.
- (E) All of the above.

Choice (E) is the most correct answer because (A) - (D) would provide the proper basis for a rejection pursuant to 35 U.S.C. § 101. The claim in (A) would provide the proper basis for a rejection pursuant to 35 U.S.C. § 101 because the composition is naturally occurring.

MPEP § 706.03(a). The claim in (B) would provide the proper basis for a rejection pursuant to 35 U.S.C. § 101 because patentability of a product claimed by a product-by process claim is based on the product itself. MPEP § 2106. Since the product is naturally occurring, the claim provides the basis for a proper rejection under 35 U.S.C. § 101. The claim in (C) would provide the proper basis for a rejection pursuant to 35 U.S.C. § 101 because it drawn to more than one statutory class of invention, i.e., a product and a process, in the same claim and is therefore not

within one of the statutory classes set forth by 35 U.S.C. § 101. The claim is properly rejectable under 35 U.S.C. § 112, second paragraph. MPEP § 2173.05(p). The claim in (D) would provide the proper basis for a rejection pursuant to 35 U.S.C. § 101 because mathematical equations alone are not patentable subject matter. MPEP § 2106.

Petitioner contends that choice (D) is a most correct answer because (A) is not a proper basis, eliminating (E) as a correct answer. Petitioner does not argue that (B) or (C) are improper bases, but selects (D) as the best choice among (B), (C) and (D) given that there is no choice for the combination of (B), (C) and (D). Petitioner argues choice (A) is an improper basis because the man made solution of salt water is not a naturally occurring composition and even if it were, such a composition is patentable as an article of manufacture.

Petitioner's arguments are not persuasive. The claim in choice (A) includes the naturally-occurring salt water within its scope. Choice (D) is not the correct answer because mathematical algorithms alone are not patentable. Petitioner provides no basis for the argument that naturally occurring substances may be patented as articles of manufacture and does not distinguish the facts of the question from Ex parte Grayson, 51 USPQ 413 (Bd. App. 1941). Since the product is naturally occurring, the claim provides the basis for a proper rejection under 35 U.S.C. § 101. Petitioner has argues that the solution technically cannot be a naturally occurring substance. Irrespective of petitioner's assumptions regarding the technological constraints implied in the question, the problem specifically states "she could obtain the exact same solution that she discovered while vacationing, by mixing NaCl with water followed by heating the mixture to 212°F and cooling it to 80°F", i.e. the resultant composition is exactly the same as the naturally occurring substance found while vacationing. The question required an assumption of identity

between the man made and naturally occurring substances. Equally important, petitioner has not shown that choices (C) and (D) are improper bases for 35 USC § 101 rejections. Thus, (A) alone is inappropriate/incorrect for the situation presented in the question. No error in grading has been shown. Petitioner's request for credit on this question is denied.

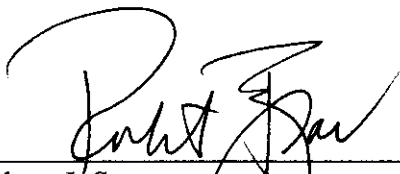
No error in grading has been shown as to questions 3, 7 and 34 of the afternoon session of the Registration Examination held on November 3, 1999. Petitioner's request for credit on these questions is denied.

ORDER

For the reasons given above, three points have been added to petitioner's score on the Examination. Therefore, petitioner's score is adjusted to 68. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy